

### REMARKS

Applicant has carefully studied the final Examiner's Action mailed May 5, 2005 and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

#### ***Claim Rejections - 35 U.S.C. § 102***

Applicant acknowledges the quotation of 35 U.S.C. §112.

Claim 7 stands rejected under 35 USC 112, second paragraph for failing to particularly and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office requested clarification of whether the "sleeve panels" of claim 7 referred to a structure separate from that claim in claim 1. Applicant has amended claim 7 to remove this ambiguity and thanks the Office for pointing out the ambiguity.

#### ***Claim Rejections - 35 U.S.C. § 102***

Applicant acknowledges the quotation of 35 U.S.C. §102(b).

Claims 1, 3, 5, 6, and 7 stand rejected under 35 U.S.C. §102(b), as being anticipated by Beauchamp et al, US 4,995,116 (hereinafter the '116 patent). Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Paolacci, Des. 412,388 (hereinafter the '388 patent).

It is well settled that "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration."<sup>1</sup> The single reference must also disclose each element of the claimed invention "as arranged in the claims."<sup>2</sup> It is not enough that the reference teach all the claimed elements in isolation, or in a different relation. Therefore, if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation cannot be found.<sup>3</sup>

<sup>1</sup> See *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303,313 (Fed. Cir. 1983).

<sup>2</sup> See *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1542, 221 USPQ 481, 485 (Fed. Cir. 1984).

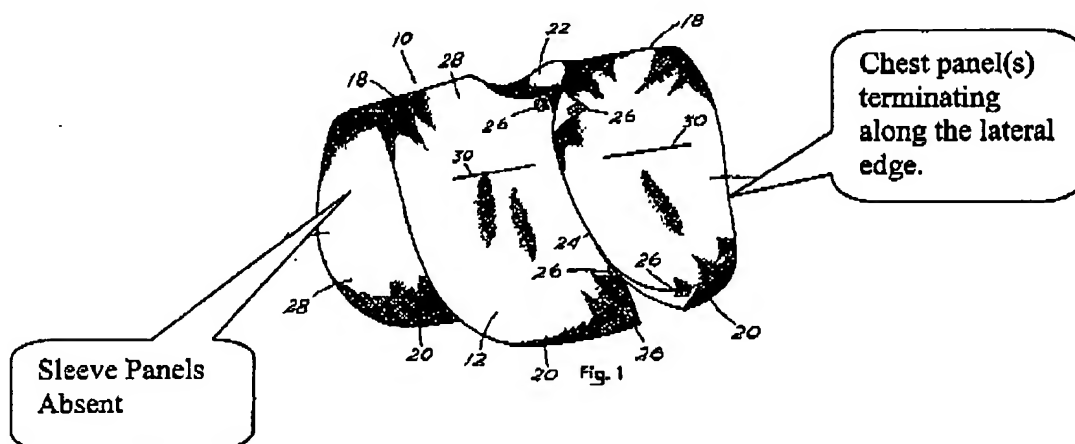
<sup>3</sup> Donner, Irah H; *Patent Prosecution; Practice and Procedure Before the U.S. Patent Office*; BNA Books, 1999

Accordingly, Applicant respectfully presents the following remarks with regard to the cited prior art:

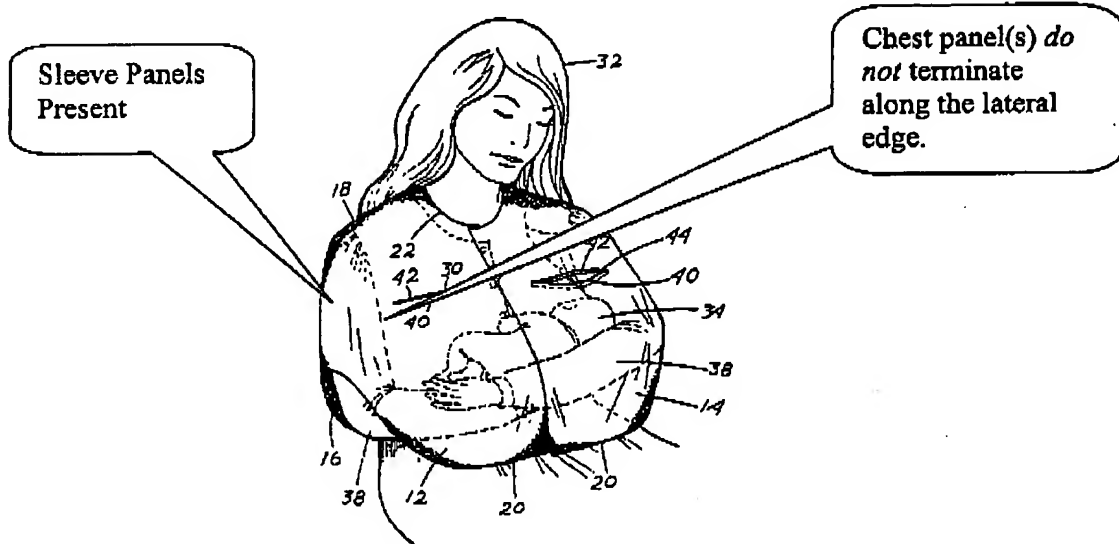
**The '116 Patent to *Beauchamp et al.***

Claims 1, 3, 5, and 6 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by the '116 patent. The '116 patent discloses two embodiments, designated (A) and (B) in the following illustrations. Embodiment A shows a nursing cape wherein the front of the garment comprises two chest panels which terminate at their lateral ends, however there are no sleeve panels. Embodiment B shows an embodiment wherein the front of the garment comprises chest panels which *do not* terminate at their lateral ends, but rather form a continuous surface with the "sleeve panels" which in turn are continuous with the back panel, thus forming a true cape.

Embodiment A



## Embodiment B

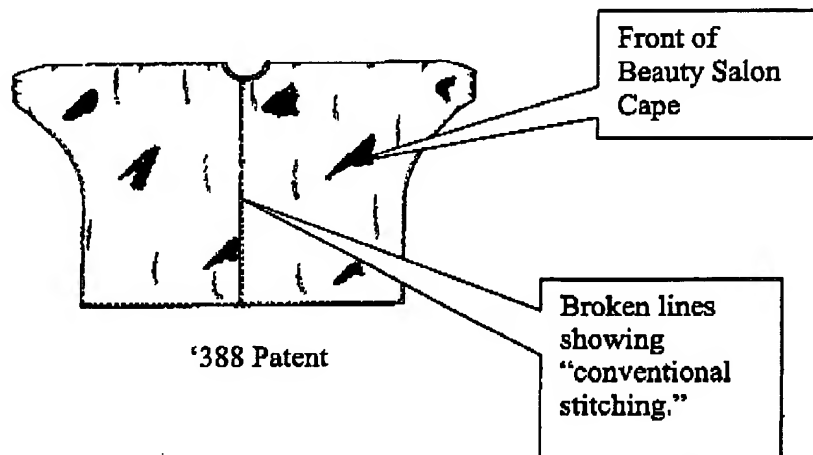


As it can be seen, the '116 patent does not describe an embodiment wherein the garment comprises *both* sleeve panels *and* chest panels having a medial and *lateral side*. In the embodiment wherein the garment comprises sleeve panels, there is no discernable *lateral side* to the chest panels. Moreover, since claims 3, 5, 6, and 7 depend from claim 1, and thereby contain all elements therein, they are also patentable over the cited reference as a matter of law. Applicant also notes there is no teaching in the '116 which provides any motivation to combine the separate embodiments.

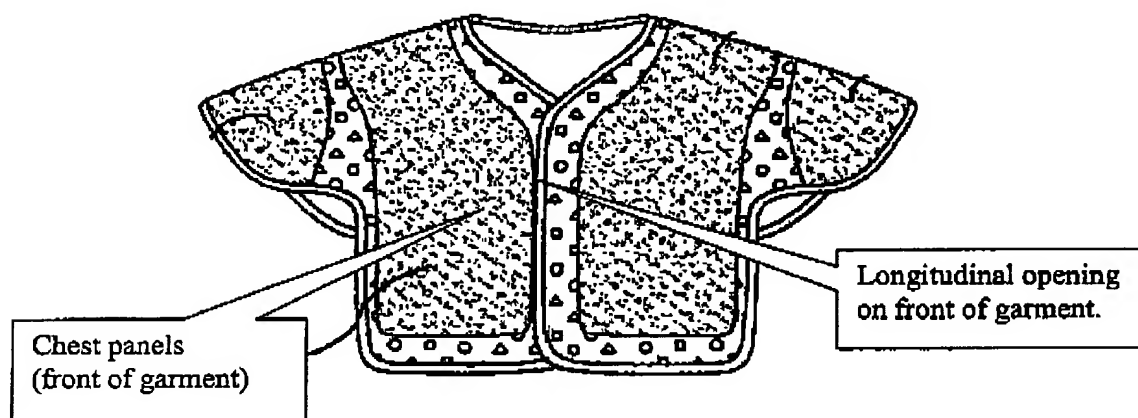
#### The '388 Patent to *Paolacci*

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by '388 patent. The '388, does not teach, describe, or suggest a protective garment having two chest panels, each having a medial and lateral side, depending from an associated shoulder panel, thereby defining a generally longitudinal opening between each chest panel and the back panel, in laterally spaced relation to one another. Rather, the cape of the '388 patent discloses a garment comprising a

chest panel of unitary configuration.<sup>4</sup> As described in Fig. 1, the dotted lines down the center of the unitary chest panel denote "conventional stitching" and not an opening.



Instant Invention



<sup>4</sup> See Fig. 1, described as a front elevational view.

In contrast to the instant invention, the garment of the '388 patent opens in the rear thereby forming two back panels which overlap. The instant application expressly recites both a garment having a back panel and two chest panels, each having a medial and lateral side, depending from an associated shoulder panel, thereby defining a generally longitudinal opening between each chest panel and the back panel, in laterally spaced relation to one another.

There is no teaching in the '388 patent, or any prior art cited by the office, to suggest reversing the configuration of the garment as shown.

***Claim Rejections - 35 U.S.C. § 103***

Applicant acknowledges the quotation of 35 U.S.C. §103(a).

To establish a *prima facie* case of obviousness there must be (1) some suggestion or motivation to combine the references, (2) a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations.<sup>5</sup> Moreover, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.<sup>6</sup>

Here, claims 4-7 stand rejected as being obvious, under 35 U.S.C. §103(a), under the '388 patent in view of U.S. Patent No. 3,798,674 to *Daniel* (hereinafter the '674 patent). The '674 patent, like the '388 patent, discloses a garment which lacks two chest panels, each having a medial and lateral side, depending from an associated shoulder panel, thereby defining a generally longitudinal opening between each chest panel and the back panel, in laterally spaced relation to one another.<sup>7</sup>

Claims 4-7 depend from claim 1, which has been shown to be patentable, and thereby contain all elements therein; they are also patentable over the cited reference as a matter of law. Furthermore, the '388 and '674 patent do not alone, or in combination, teach or suggest all the claim limitations cited in the application and therefore do not anticipate the instant invention.

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<sup>5</sup> MPEP §2142.

<sup>6</sup> *In re Frisch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

<sup>7</sup> U.S. Patent No. 3,798,674 to *Daniel*, Figs 1-5.

***Information Disclosure Statement***

The information disclosure statement filed 11/9/2004 was not considered by the Office because it did not contain a statement as specified in 37 C.F.R. 1.97(e). The IDS complied with all the requirements of 37 C.F.R. 1.98.

Applicant, by virtue of this pleading, has requested continued examination (RCE) of this important application. Information filed in an application in compliance with 37 C.F.R. 1.98 before the filing of an RCE will be considered by the Examiner after the filing of the RCE. For Example, an applicant filed an IDS in compliance with 37 C.F.R. 1.98 after the mailing of a final Office action, but the IDS did not comply with the requirements of 37 C.F.R. 1.97, and therefore was not considered by the examiner. After applicant files an RCE, the examiner will consider the IDS filed prior to the filing of the RCE. (MPEP §609, I, B, 4)

Accordingly, Applicant respectfully requests the Examiner consider the references included in the IDS of November 11, 2004.

***Conclusion***

Entry of a Notice of Allowance is solicited. If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

By: 

Dated: August 4, 2005

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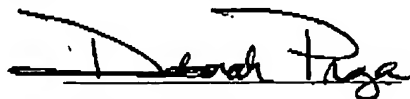
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CERTIFICATE OF FACSIMILE TRANSMISSION

(37 C.F.R. 1.8 (a))

I HEREBY CERTIFY that this Amendment A after RCE, including Remarks, is being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 3765, Attn: Amy B. Vanatta, (571) 273-8300, on August 4, 2005.

Dated: August 4, 2005



Deborah Preza